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EXAMINER

THANH, QUANG D

ART UNIT	PAPER NUMBER
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3764

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/031,161
Filing Date: May 20, 2002
Appellant(s): LYAPKO, NIKOLAI GRIGORIEVICH

MAILED

FEB 24 2006

Group 3700

Irving M. Weiner
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 01/23/2006 appealing from the Office action mailed 06/07/2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

WITHDRAWN OBJECTIONS

The following ground of objection is not presented for review on appeal because it has been withdrawn by the examiner. In view of the appellant's remark on pages 11-12, the objection under 35 USC 132 (a) regarding "the term 'two layers' in claim 27 adds material which is not supported by the original disclosure" has been withdrawn.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,250,067	GELFER et al.	10-1993
3,923,064	LEUPOLD	12-1975
JP 407100181A	YONEDA et al.	04-1995

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 19, 21, 23, 27, 29, 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gelfer et al. in view of Leupold.

Re claims 19, 21 and 23, Gelfer teaches a body treatment pad having a flexible base member 10 made of plastic material and a plurality of needles 19 ("rigid needle-like protuberance as disclosed in col. 1, line 14-16) each having a thickened end and a sharpened tip 23 (fig. 6) being tapered from the thickened end toward the sharpened end (fig. 6). Since the base member is made of plastic material having "sufficient flexibility" (col. 3, lines 4-10), therefore it has a certain degree of elasticity. Gelfer does not disclose the thickened end of the needle being embedded inside of the base member. However, Leupold teaches that a needle 8 may be embedded in a base

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material (see fig. 3), the needle having a thickened end 9 in the form of a head (fig. 3 shows thickened end head 9). Therefore, it would have been obvious to one skilled in the art to embed the needles having a thickened end head within the base, as taught by Leupold, for the purpose of further stabilizing the anchoring of the needles to the base, thus preventing the needles from breaking off. Regarding the steps of making the pad recited in these claims, it is noted that such steps are being considered as a product-by-process limitations and thus are not given patentable weight, as they do not further limit the structure of the device.

Re claims 27, 29 and 31, the device of Gelfer as modified by Leupold teaches a body treatment pad having a flexible base member 10 made of plastic material and a plurality of needles 19 embedded in the base member, each having a thickened end and a sharpened tip 23 (fig. 6) being tapered from the thickened end toward the sharpened end (fig. 6), the thickened end has the form of a head (Leupold, fig. 3 shows thickened end head 9), except for the two layers. However, Gelfer already teaches that the base member 10 is a sheet made of plastic material, and it would have been obvious to one having ordinary skill in the art at the time the invention was made to select two or more layers of plastic material to form the sheet, with the needles embedded between the layers in the base member, as taught and suggested by Leupold, since it has been held that constructing a formerly integral structure in various elements (layers) involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

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Claims 20, 22, 24-26, 28,30, 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gelfer et al in view of Leupold as applied to claims above, and further in view of Yoneda et al. The device of Gelfer et al. as modified by Leupold does not disclose lugs surrounding the needles and being disposed on the base member. However, Yoneda et al disclose a cone or pyramidal shaped needle (fig. 2 and 6) that could be modified in the form of a nail-shaped needle 12 that includes an increased thickness 15, with a lug 13 (best seen in fig. 7 and 8). Therefore, it would have been obvious to one skilled in the art to modify the needle of Gelfer/Leupold to have lugs disposed on the base member and surrounding the needles, as taught by Yoneda, for the purpose of providing a lug to serve as stabilizing means that allows for increased retention of the needle.

(10) Response to Argument

Appellant's arguments filed 1/23/06 have been fully considered but they are not persuasive.

Whether claims 19, 21, 23, 27, 29 and 31 are unpatentable under 35 USC 103 over Gelfer US 5,250,067 in view of Leupold US 3,923,064.

In response to appellant's argument on p. 13 that "Thus, it is clear that Gelfer elongated bar 19 is not a fine, sharp projection, as a spine of a sea urchin or crystal, or a sharp, pointed instrument used in engraving, and thus, Gelfer elongated bar 19 is not a needle", the examiner respectfully disagrees. It is not clear how the appellant can disregard Gelfer's teaching, which clearly discloses that "The invention concerns a

flexible pad having a large multiplicity of rigid **needle**-like protuberances" (col. 1, lines 14-16).

In response to appellant's argument on p. 14 that "Gelfer states that sheet 10 can be canvas, or heavy cloth, or a thin sheet of non-woven plastic material, a prime consideration is that the sheet 10 has sufficient flexibility to conform to the contours of a person's body, e.g., wrapped around a person's arm or lying against a person's back. Gelfer, col. 3, lines 7-12. Appellant respectfully submits that the Gelfer sheet 10 being made of canvas or heavy cloth, or a thin sheet of non-woven plastic material is not an 'elastic' base member, as required in appellant's claims", it is unclear to the examiner how the appellant can disregard Gelfer's teaching, which clearly discloses "that the sheet 10 has **sufficient flexibility** to conform to the contours of a person's body". Moreover, since Gelfer teaches that sheet 10 can be canvas, or heavy cloth, or a thin sheet of **non-woven** plastic material, therefore according to Hawley's Condensed Chemical Dictionary, 14th Edition, "nonwoven fabric" is defined as a fabric made from thermoplastic synthetic fiber and the sheets thus formed can be pressed together to form mats of good elastic recovery (see attached) and thus Gelfer's thin sheet of **non-woven** plastic material is elastic.

In response to appellant's argument on p. 15 that "appellant respectfully submits Leupold element 8 is not a needle; and also does not have a sharpened end", the examiner respectfully disagrees. Leupold clearly shows in fig. 3 that element 8 is a "pointed instrument" and thus appears to comprehend the claimed language "needle".

Moreover, it is noted that it is irrelevant whether Leupold's element 8 is a needle, since Leupold is cited specifically to teach a similar device having pointed acupressure element 8 that can be embedded in a base material (see fig. 3).

In response to appellant's argument on p. 15 that "none of the cited references discloses the 'squeezed' feature of appellant's claims", the examiner respectfully disagrees. Appellant's attention is directed to Leupold's fig. 3, which clearly show the element 8 is being squeezed when embedded in the base material.

In response to appellant's argument on p. 16 that "Leupold teaches away from the appellant's claimed invention. For example, Leupold teaches a ring-shaped holder having means defining a rigid pressure plate", the examiner respectfully disagrees. While Leupold may teaches a ring-shaped holder having means defining a rigid pressure plate, Leupold also teaches that pointed pressure element 6 can be disposed on the surface of the base material (fig. 2) or alternatively pointed pressure element 8 can be embedded in the base material (fig. 3).

In response to appellant's argument on p. 16 that "appellant respectfully submits that Gelfer et al. and Leupold do not contain any justification to support their combination, much less in the manner proposed", the examiner respectfully disagrees. Gelfer disclose the claimed invention except for the thickened end of the needle being embedded inside of the base member. However, Leupold teaches that a needle 8 may be embedded in a base material (see fig. 3), the needle having a thickened end 9 in the form of a head (fig. 3 shows thickened end head 9). Therefore, it would have been obvious to one skilled in the art to embed the needles having a thickened end head

within the base, as taught by Leupold, for the purpose of further stabilizing the anchoring of the needles to the base, thus preventing the needles from breaking off.

In response to appellant's argument that "the applied references each teach features aimed at solving different problems is not sufficient to gratuitously and selectively substitute parts of one reference (Leopold) for a part of another reference (Gelfer) in order to meet appellant's novel claimed combination", the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

In response to appellant's remarks on p. 18-21, it is noted that appellant's has recited claimed features without pointing out the differences between the present application and the prior art. It is also noted that applicant argued on p. 19 that "the proposed combinations would not be physically possible nor operative" but has not pointed out why not.

In response to appellant's argument that the reference does not disclose "A device for reflexology", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference

as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

In response to a appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Whether claims 20, 22, 24-26, 28, 30, and 32-34 are unpatentable under 35 USC 103 over Gelfer US 5,250,067 in view of Leupold US 3,923,064, and further in view of Yoneda JP 407100181.

In response to a appellant's argument on p. 22 that "Yoneda does not disclose 'lugs surrounding, **contacting and enveloping stems of** said needles' as set forth in claims 20 and 28", it is noted that the language "**contacting and enveloping stems of**" said needles is not recited in claim 20 and 28. The claims only require "lugs surrounding said needles". Appellant's attention is directed to Fig. 7-8, which clearly show a nail-shaped needle 12 that includes an increased thickness 15 with a lug 13 surrounding the needle.

In response to appellant's argument on p. 23 that "Yoneda Fig. 2 does not disclose a cone shaped needle". In contrast, Yoneda Fig. 2 discloses an acute projection

2” and that “Yoneda Fig. 6 does not disclose a pyramidal shaped needle”, the examiner respectfully disagrees. According to applicant’s remark on p. 13 that “The American Heritage Dictionary defines ‘needle’ as a fine, sharp projection ... or a sharp, pointed instrument”, therefore the **sharp pointed acute projection** in figs. 2 and 6 appears to comprehend the claimed language “needle”.

In response to appellant's argument on p. 23 that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Gelfer discloses the claimed invention having all the features, except for the needle being embedded in the base member and lug surrounding the needle. Leupold is cited to teach a similar acupressure device having a needle embedded in a base material (see fig. 3). Therefore, it would have been obvious to one skilled in the art to embed the needles within the base, as taught by Leupold, for the purpose of further stabilizing the anchoring of the needles to the base, thus preventing the needles from breaking off. Yoneda is further cited to teach a similar device having a nail shaped needle 12 which is surrounded by a lug 13 (best seen in fig. 7 and 8). Therefore, it would have been obvious to one skilled in the art to include lugs disposed on the base member and

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surrounding the needles, as taught by Yoneda, for the purpose of providing a lug to serve as stabilizing means that allows for increased retention of the needle during use.

In response to appellant's argument on p. 23 that "three references must be combined to allegedly meet claims 20, 22-26, 28 and 30-34 is further evidence of unobviousness", it is noted that reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

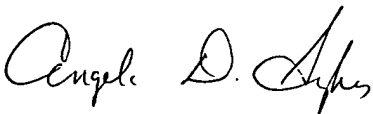


Quang D. Thanh
Patent Examiner
Art Unit 3764

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Angie Sykes

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Supervisor Patent Examiner



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nonwoven fabric (cloth) .

A fabric made from staple lengths of cotton, rayon, glass, or thermoplastic synthetic fiber mechanically positioned in a random manner and usually bonded with a synthetic adhesive or rubber latex. The sheets thus formed can be pressed together to form porous mats of high absorptivity and good elastic recovery on deformation. Permanent bonds are formed where the fibers touch each other as a result of heat treatment when the fibers are thermoplastic or by use of a high-polymer binder. Disposable filters of polyethylene and polyester can be made without a binder.

A specialty nonwoven (so-called "melded") fabric trademarked "Cambrelle" is a composite of two different polymers; heating the exterior layer to its melting point causes the fibers to fuse into a fabric.

Use: Applications are as a backing for plastic film; padding for surgical dressings, diapers, sanitary napkins; drapes and other decorative textile products; filtration; shoe liners; industrial wiping and polishing fabrics; disposable clothing; carpet backing.

Hawley's Condensed Chemical Dictionary, 14th Edition
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